

Attorney Docket No. POS-03602/29

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Posa

Serial No.: 09/851,911

Group No.: 3728

Filed: May 9, 2001

Examiner: T. Kavanaugh

For: FOOTWEAR FOR PERSONALIZED FOOTPRINTS

APPELLANT'S REPLY TO EXAMINER'S ANSWER

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

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TECHNOLOGY CENTER R3700

Dear Sir:

Appellant's submits the following arguments in response to the Examiner's Answer, wherein the Examiner raises new points of argument, thereby triggering a justification for a separate response.

Group 1

With regard to Group I, the Examiner states new case law, and makes new arguments regarding the "law of anticipation." The Board must note, however, that claim 1 on appeal was previously amended to include specific size limitations which are not present in the reference used by the Examiner, namely, Ellis (WO 91/11924). Accordingly, the "law of anticipation" simply does not apply, since Ellis does not teach each and every element of Appellant's invention as claimed, either explicitly or under principles of inherency.

That said, the only argument remaining to the Examiner is obviousness, and it is obviousness rejection that Appellant argues the separate goals and purposes to which the cited reference and instant invention are directed. Appellant is not relying entirely on mere "field of use" or other such "limitations" to conclude that Ellis does not apply under §103, but rather, makes the argument that the structure of Ellis were somehow forced to "read on" Appellant's claim 1, it would render the invention of Ellis unfit for its intended purpose. It is well settled under §103 that

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obviousness cannot be applied where a prior-art reference would be fit for its intended purpose. There is nothing obvious about that. In terms of structure, the Board should note that the rejections of claim 1 not only include a specific size range, but that they are "removable," and that removability is stated as a positive limitation as opposed to something more functional such as "may be removed." Although the Examiner argues that this affords no "unexpected result," with regard to more conventional footwear, including the embodiments of Ellis, the removal of a portion of the sole would clearly be an unexpected result, since the references cited by the Examiner intentionally provide for structures that enhance traction. Removal of those same structures to reduce traction would certainly be an unexpected, nonobvious result.

Group 2

The Examiner raises the new argument that although the figures previously cited of Ellis as not showing a densely-packed matrix of projection surrounded by a partition border should be gleaned from the specification of Ellis as a "variant" or "alternative embodiment," is improper on several grounds. First, Appellant can only respond to the arguments previously made by the Examiner of record, such that initiating new arguments at this late stage in the proceedings is unfair in terms of Appellant's ability to respond. But in addition, although it is the Examiner's opinion that the various disclosures of the Ellis reference may be combined in any fashion necessary to reject Appellant's claims, Appellant cannot find those sections of Ellis where limitations of this group are actually met. Accordingly, anticipation and obviousness are both precluded.

Group 3

The Examiner raises the new argument that "as long as some motivation or suggestion to combine references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor." The problem with this argument is that even if these references were combinable, which Appellant argues they are not, the instant invention as set forth in this group of claims would not result. It must be kept in mind that Appellant's invention has to do with creating a message on the sole portion of a shoe so that an impression may be left while walking, for example. In all embodiments of Appellant, a densely-packed matrix of projections is provided throughout the sole so that they may be selectively plucked

to generate this message. By having only the sole portion transparent, makes no sense in view of Appellant's invention as claimed. Thus, apart from any *clear* motivation to combine, Appellant's purpose in this group of claims would be defeated, since only the toe portion could be personalized assuming, again, that this improper combination were to be sustained.

Group 4

Group 4 includes the single claim 16, which set forth, in combination, a sandal or thong having a bottom surface with densely-packed removable projections enabling a user to selectively remove these projections and leave a personalized imprint on wet sand or another purpose. This claim also stands rejected under 35 U.S.C. §103 over Ellis as well. The Examiner makes the new grounds of argument that "sandals and thongs are known in the art to desire traction to [sic]. Specifically sports sandal [sic] have a plurality of traction elements on the bottom of the shoe sole." Since the Examiner is not citing any prior art in support of these new arguments, how is Appellant supposed to respond? How is Appellant supposed to know which sandals or thongs have enhanced traction to the extent implied by the Examiner? Moreover, it is not Appellant's argument that sandals or thongs *cannot have traction*. Rather, Appellant is responding to the Examiner's rejection of the claim of this group based upon Ellis under 35 U.S.C. §103(a). There is no reason under the law why Appellant needs to broaden his response to any personal opinion or "official notice" on the part of the Examiner. Given that Ellis is directed to a sports shoe with laces and other features to enhance traction, it would defeat the purpose of Ellis to provide such a shoe in the form of a sandal or thong, since running or playing sports with such a shoe would be impractical, if not dangerous. Accordingly, *prima facie* obviousness has not been established.

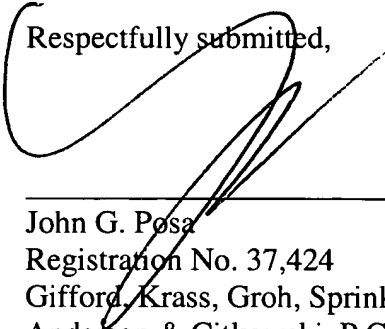
For all of the reasons set forth above, coupled with those already made of record in Appellant's initial brief, the Board is respectfully solicited to concur and allow all of the claims in the instant application.

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Respectfully submitted,



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